

REMARKS**Summary of the Office Action**

In the Office Action, claims 14-30 stand rejected as being unpatentable over U.S. Patent No. 6,153,279 to *Charley* in view of U.S. Patent No. 5,641,116 to *Martin*.

Summary of the Response to the Office Action

In view of the arguments presented below, claims 14-30 are pending for further consideration.

All Claims are Allowable

In the Office Action, claims 14-30 stand rejected as being unpatentable over U.S. Patent No. 6,153,279 to *Charley* in view of U.S. Patent No. 5,641,116 to *Martin*. Applicant traverses this rejection for the following reasons.

With regard to independent claim 14, Applicant respectfully maintains that *Charley* and *Martin*, whether viewed singly or in combination, do not teach or suggest a method of manufacturing a clean release magnet, the method including the steps of, “printing information on a label layer having adhesive on at least one surface, thereby denoting a first layer; affixing a pressure sensitive carrier layer, having a clean release adhesive on a first surface and an adhesive on a second surface, to a magnet layer, to thereby denote a second layer; and affixing said first layer to said second layer, adjacent said magnet layer, to thereby denote a third layer, and simultaneously cutting said third layer to a predetermined depth, wherein said magnet layer is one of non-tacky and slightly-tacky when removed from said pressure sensitive carrier layer, and a surface of said magnet layer is exposed when removed from said pressure sensitive carrier layer such that when said exposed surface is magnetically attached to a metal surface, said exposed surface directly contacts the metal surface,” as recited in independent claim 14, as amended.

Support for these features recited in claim 14 can be found at least in Paragraphs 21-25 and 29-39 of the originally filed specification, and in Figs. 1-4 of the originally filed drawings, and new Fig. 6. Specifically, as shown in Fig. 6, the present invention discloses a method of manufacturing a clean release magnet 10. The method includes the steps of printing information

on a label layer (i.e. printed filmic face) 14 having adhesive on at least one surface, thereby denoting a first layer. The method further includes the step of affixing a pressure sensitive carrier layer 11, having a clean release adhesive 13 on a first surface and an adhesive on a second surface, to a magnet layer 12, to thereby denote a second layer. The method also includes the step of affixing the first layer to the second layer, adjacent magnet layer 12 (see Fig. 1), to thereby denote a third layer, and simultaneously cutting the third layer to a predetermined depth. Based upon the aforementioned method, magnet layer 12 is non-tacky (or perhaps slightly-tacky) when removed from pressure sensitive carrier layer 11. Moreover, once removed, a surface of magnet layer 12 is exposed when removed from pressure sensitive carrier layer 11 such that when the exposed surface is magnetically attached to a metal surface, the exposed surface directly contacts the metal surface

The Office Action cites *Charley* and *Martin* as teaching or suggesting the method as recited in independent claim 14 of the present invention.

Charley, as illustrated in Fig. 2 and discussed in Col. 2:25-67, discloses a method of forming a label having a flexible magnet provided therewith. The label 10 disclosed by *Charley* includes from top to bottom, a printed material layer 14 adhered to a top surface 16 of flexible magnet 12, magnet 12 further including bottom surface 22 adhered to clear base material 20 by means of solvent based adhesive 29. Label 10 further includes clear film 24 adhered to liner 28 by means of adhesive backing 26. In operation, as illustrated in Fig. 2 and discussed in Col. 2:56-67, clear base material 20 may be separated from clear film 24 by means of the chemical bonding between the two layers. Specifically, as discussed in Col. 2:58-62, it is stated that clear base material 20 and clear film 24 are formed of Technicote Magic Film™, which consists of two film layers that have been chemically bonded.

Applicant respectfully asserts that the chemical bonding provided by the Technicote Magic Film™ disclosed in *Charley* is by no means equivalent in structure or operation, nor is it an obvious substitute for the clean release adhesive layer recited in independent claim 14 of the present invention.

The Office Action thereafter cites *Martin* (U.S. Patent No. 5,641,116) as teaching the use of a clean-release. Specifically, as shown in Fig. 5 of *Martin*, *Martin* discloses a card 100 including a spacer 32 removably attached to magnetic sheet material 24 by adhesive means 30,

which is a repositionable non-permanent adhesive, (Col. 2:49-67). The particular embodiment of Fig. 5 is disclosed for use of the card as a mailer, (Col. 1:37-38).

Thus *Martin* clearly teaches that adhesive layer 30 is a “repositionable non-permanent adhesive.” In other words, the adhesive for adhesive layer 30 retains it’s adhesive properties, and therefore allows magnet layer 24 and/or spacer 32 to be repositioned (i.e. re-attached) to each other.

Contrary to the holding of the Office Action, Applicant respectfully asserts that one of ordinary skill in the art would not be motivated to combine the teachings of *Charley* and *Martin* to obtain the clean release label manufactured per the method of the present invention. Further, even if the teachings of *Charley* and *Martin* were to be combined as suggested, one of ordinary skill in the art would still not obtain the clean release label manufactured per the method of the present invention.

For example, whereas *Charley* discloses the use of releasably bonded film layers 20, 24 which can be separated to allow magnet 12 having film layer 20 bonded thereto to be magnetically attached to a surface, the use of layers 20, 24 is essential for *Charley* so as to allow magnet 12 to have a film layer with no exposed adhesive. In other words, as discussed in Col. 1:50-53 of *Charley*, an “object and advantage of the present invention is that when the magnet is removed from the substrate, there is no exposed adhesive on either the magnet or the substrate,” (Col. 1:50-53).

Accordingly, referring to Fig. 1 of *Charley*, *Charley* clearly teaches that the when magnet 12, having film layer 20 bonded thereto, is removed from film layer 24, there is no exposed adhesive on either the magnet or the substrate.

Contrary to the express teachings of *Charley*, as discussed above, *Martin* clearly teaches that the adhesive layer 30, as shown in Fig. 5 of *Martin*, is a “repositionable non-permanent adhesive.” As also discussed above, the adhesive for adhesive layer 30 of *Martin* therefore retains it’s adhesive properties, and therefore allows magnet layer 24 and/or spacer 32 to be repositioned (i.e. re-attached) to each other.

Thus *Martin* clearly does not teach or suggest the use of a “clean-release adhesive” as positively recited in independent claim 14 of the present invention.

Applicant therefore respectfully maintains, that *Charley* and *Martin*, whether viewed singly or in combination as suggested in the Official Action, fail to teach or suggest the invention as recited in independent claim 14 of the present invention.

As pointed out in M.P.E.P. § 2143.03, "[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art". *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). Since this criterion has not been met, Applicant respectfully asserts that the rejection under 35 U.S.C. § 103 (a) should be withdrawn because *Charley* and *Martin* do not teach or suggest each feature of independent claim 14.

In view of the above arguments, Applicant respectfully requests the rejection of independent claim 14 under 35 U.S.C. § 103 be withdrawn. Additionally, claims 15-27, which depend from independent claim 14, are allowable at least because their base claim is allowable, as well as for the additional features recited therein.

Independent claim 28

With regard to independent claim 28, Applicant respectfully maintains that *Charley* and *Martin*, whether viewed singly or in combination, do not teach or suggest a method of manufacturing a clean release magnet, the method including the steps of, "providing a label layer having adhesive on at least one surface, thereby denoting a first layer; affixing a pressure sensitive carrier layer, having a clean release adhesive on a first surface and an adhesive on a second surface, to a magnet layer, to thereby denote a second layer; and affixing said first layer to said second layer, adjacent said magnet layer, to thereby denote a third layer, and simultaneously cutting said third layer to a predetermined depth, wherein said magnet layer is one of non-tacky and slightly-tacky when removed from said pressure sensitive carrier layer, and a surface of said magnet layer is exposed when removed from said pressure sensitive carrier layer such that when said exposed surface is magnetically attached to a metal surface, said exposed surface directly contacts the metal surface," as recited in independent claim 28.

Applicant respectfully maintains that independent claim 28 is allowable at least for the reasons presented above for the allowance of independent claim 14, and the additional features recited therein. In the interest of avoiding redundant arguments, the reasons for allowance of independent claim 28 are not repeated herein. Additionally, claims 29 and 30, which depend

from independent claim 28, are allowable at least because their base claim is allowable, as well as for the additional features recited therein.

CONCLUSION

In view of the foregoing, Applicant respectfully requests the entry of this Amendment to place the application in clear condition for allowance or, in the alternative, in better form for appeal. Applicant also requests the Examiner's reconsideration and reexamination of the application and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicant's undersigned representative to expedite prosecution.

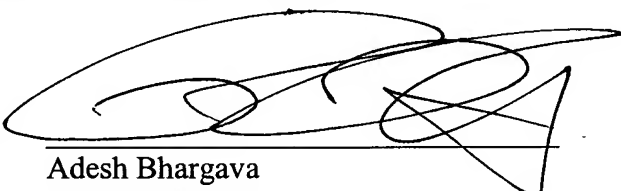
If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 04-2223. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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